

REMARKS

Claim 38 is the sole claim pending in this application. The above amendment to claim 38 is supported throughout the specification, including at page 8, lines 25-26, and Example 1 at pages 18-20. No new matter has been added.

Interview Summary

On September 8, 2004, the undersigned telephoned the Examiner to point out that the Restriction Requirement mailed on August 13, 2004, was improperly based on claims no longer in the case. The Preliminary Amendment filed May 14, 2001, canceled claims 1-37 and added new claim 38. The Examiner agreed to withdraw the Restriction Requirement and examine claim 38.

35 U.S.C. §112, ¶1

The Examiner rejected claim 38 as lacking written description, alleging that “the specification only teaches one representative species, SEQ ID NO:2, from *Kluyveromyces aestuarii*, having the properties recited in claim 38. One representative species is not enough to describe the whole genus...” The Examiner further alleged that “the specification, while being enabling for carbonyl reductase of SEQ ID NO:2, does not reasonably provide enablement for carbonyl reductase different from SEQ ID NO:2.” Applicants disagree with both of these allegations, but in order to further prosecution have limited the claim to a carbonyl reductase that is derived from *Kluyveromyces aestuarii*. The carbonyl reductase of amended claim 38 can be isolated and purified by one of ordinary skill in the art using methods described in, for example, Example 1 of the specification. Applicants submit that claim 38 as amended fulfills both the written description and enablement requirements and request withdrawal of the rejection.

35 U.S.C. §102(b)

The Examiner rejected claim 38 as anticipated by Peters et al. (Enzyme Microb. Technol. 15:950-8), who teach a carbonyl reductase from *Candida parpsilosis*. The Examiner states that

"[t]he carbonyl reductase of Peters et al. ... has an optimum pH of 6.0 (abstract), [and] has a molecular weight of about 32 kDa." It is unclear on what the Examiner bases this statement, as the document discloses that "[t]he subunit size estimated by SDS-gel electrophoresis was 67 kDa..." (page 953) and that the enzyme has a "relatively broad pH optimum between pH 6.5 and 9.0" (abstract). Thus, the Examiner has not come even close to establishing that Peters et al. disclosed an enzyme that falls within claim 38, even prior to the present amendment. In view of those distinctions as well as the present amendment of claim 38, Applicants request withdrawal of the rejection.

Double Patenting

The Examiner rejected claim 38 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6,312,933. Applicants enclose a terminal disclaimer and appropriate fee in accordance with 37 CFR §§ 3.73(b) and 1.321(b). Applicants submit that this obviates the rejection and request its withdrawal.

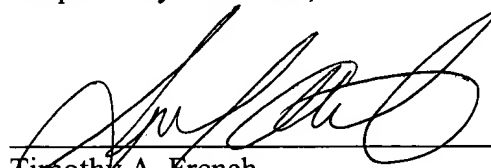
Applicants respectfully request allowance of the claim.

Please apply any charges or credits to deposit account 06-1050, referencing Attorney Docket No. 14879-050002.

Respectfully submitted,

Date: _____

December 20, 2004



Timothy A. French
Reg. No. 30,175

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110-2804
Telephone: (617) 542-5070
Facsimile: (617) 542-8906